

REMARKS

In the Office Action^[1], the Examiner rejected claims 1-8 and 19-22 under 35 U.S.C. §103(a) as being obvious over *Barrett et al.* (U.S. Patent No. 5,699,532, "*Barrett*") in view of *Sridhar et al.* (U.S. Patent No. 6,098,108, "*Sridhar*"). Applicant amends claims 1-8, 19, and 21. Claims 9-18 have been withdrawn. Claims 1-22 remain pending of which claims 1-8 and 19-22 are currently under examination.

I. Regarding the rejection of claims 1-8 and 19-22 under 35 U.S.C. §103(a) as being unpatentable over *Barrett* in view of *Sridhar*

Applicant respectfully traverses the rejection of claims 1-8 and 19-22 under 35 U.S.C. § 103(a) as being unpatentable over *Barrett* in view of *Sridhar*. No *prima facie* case of obviousness has been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the

^[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I)
(emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include] [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Independent claim 1 defines a method of grid computing, including "receiving one or more lists of available computing resources from a plurality of computer devices in a grid computing environment," emphasis added. The Examiner alleges *Barrett* meets this claim element through multi-path channel (MPC) interfaces using exchange identification (XID) signals that convey information about signalling paths. Office Action, p. 5. However, the multi-path channel control disclosed by *Barrett* cannot teach or suggest "receiving one or more lists of available computing resources," as alleged by the Examiner. In contrast, *Barrett* discloses that dedicated ESCON adapters are employed between homogenous computing resources. Although multiple paths exist within each multi-path connection, the connections between these devices are dedicated. *Barrett*, col. 1, line 67-col. 2, line 2. Furthermore, the exchange identification (XID) the Examiner relies upon is not used in "receiving one or more lists of available computing resources," but instead adapts serial data bursts between external I/O devices and the ESCON adapters of a mainframe computer system. *Id.*, col. 1, lines 20-24, col. 2, lines 29-36. Therefore, *Barrett* fails to teach or suggest at

least "receiving one or more lists of available computing resources from a plurality of computer devices in a grid computing environment," as recited in claim 1 (emphasis added).

Sridhar fails to cure the deficiencies of *Barret*. *Sridhar* discloses:

Database 1620 includes an address database 1624 which includes associations of server host names, server IP addresses, and IP address of remote communication servers Referring again to FIG. 16, directory manager 1610 makes use of network lookup module 1640 to access distributed directory information that it uses to determine whether a remote communication server is associated with the address of a server computer. (col. 25, lines 19-56)

Sridhar discloses a system of determining whether the networked connections in a client-server system can use an enhanced method of communication. Therefore, *Sridhar* cannot teach or suggest at least "receiving one or more lists of available computing resources from a plurality of computer devices in a grid computing environment," (emphasis added) as recited in claim 1.

In view of the deficiencies of the references discussed above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 1. Thus, the Office Action has failed to clearly articulate a reason why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1 and the rejection under 35 U.S.C. § 103(a) must be withdrawn. Claims 2-8 are also allowable at least due to their depending from claim 1.

Independent claims 19 and 21, while of different scope from claim 1 and each other, recite elements similar to those of claim 1 and are thus also allowable for reasons similar to those discussed above for claim 1. Claims 19 and 21 are, therefore, allowable for at least the reasons presented above. Claims 20 and 22 are also allowable at least due to their dependence from independent claims 19 and 21.

For at least these reasons, a *prima facie* case of obviousness has not been established with respect to claims 1-8 and 19-21 and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

In view of the foregoing remarks, Applicant requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 19, 2008

By: 

Erin M. File
Reg. No. 61,332